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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/718,523 | 11/24/2003 | Patrick Glockner | 240131US0 | 1989 |
| 22850 | 7590 | 04/10/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | GULAKOWSKI, RANDY P | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1712 | | |

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/718,523 | GLOCKNER ET AL. | |
| | Examiner | Art Unit | |
| | Jeffrey B. Robertson | 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 7-20 and 25-29 is/are rejected.
- 7) Claim(s) 6 and 21-24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 2-4, 7, 10-12, 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-4, 10-12, 15-17 contain the trademark/trade name Solvesso®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe solvent and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 8, 9, 13, 14, 18-20, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunz et al. (U.S. Patent No. 5,036,134) in view of JP 04-036364 (See attached Derwent abstract and abstract obtained from JPO Web-site).

For claims 1 and 25, Kunz teaches the polymerization of acrylic monomers in the presence of polyesters and organic solvents. Col. 5, lines 32-54. Here, for claims 18-20, Kunz teaches that the polyester is present from 5-90% by weight with the balance being the acrylic copolymer component, encompassing applicant's ranges. Kunz teaches that the polyester is carboxy-functional in col. 5, lines 6-15. For claims 1, 13, and 14, in col. 4, lines 7-19, Kunz teaches that the acrylic copolymer includes monomers such as glycidyl ethers reacted with acrylic and methacrylic acids and hydroxyl alkyl acrylates.

For claims 26 and 28, in col. 1, lines 5-19, Kunz teaches that the compositions are used as binders in coating compositions. Kunz fails to teach the presence of dicidol fraction in the polyester as set forth in claim 1.

For claims 1, 5, 8, and 9, the '364 abstract teaches the formation of polyesters containing 50-100 mol % of dicidol. See col. 1 of the Japanese document for the formula. The amount of dicidol significantly overlaps the amounts claimed by applicant. Ethylene glycol and terephthalic acid are used as other components. See the abstract from the JPO Web-site.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate dicidol into the polyesters of Kunz in the percentages set forth in the '364 reference. The motivation would have been that the '364 reference teaches

that through incorporation of dicidol into polyesters, the adherence of polyesters is improved. One of ordinary skill in the art would have wanted to take advantage of this property in the coatings of Kunz.

4. Claims 1, 5, 8, 9, 13, 14, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epple et al. (U.S. Patent No. 6,048,936) in view of JP 04-036364 (See attached Derwent abstract and abstract obtained from JPO Web-site).

For claims 1 and 25, Epple teaches the free-radical polymerization of acrylic monomers in the presence of organic solvent and polyesters having a hydroxyl number of 50 to 350 mg/g. Col. 2, lines 23-61. Here, Epple teaches that glycidyl containing unsaturated carboxylic acid monomers are used. In col. 5, lines 36-37, Epple teaches glycidyl (meth)acrylate. For claims 13 and 14, Epple teaches that other acrylic monomers such as hydroxyalkyl methacrylates are added.

For claims 26-28, in col. 8, line 54 through col. 9, line 26, Epple teaches that the products produced by the reaction set forth in the patent can be used as coating compositions and in epoxy compositions, which are used as adhesives.

For claim 29, Epple teaches curing agents such as polycarboxylic acids in col. 3, lines 5-12.

For claims 1, 5, 8, and 9, the '364 abstract teaches the formation of polyesters containing 50-100 mol % of dicidol. See col. 1 of the Japanese document for the formula. The amount of dicidol significantly overlaps the amounts claimed by applicant. Ethylene glycol and terephthalic acid are used as other components. See the abstract from the JPO Web-site.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate dicidol into the polyesters of Epple in the percentages set forth in the '364 reference. The motivation would have been that the '364 reference teaches that through incorporation of dicidol into polyesters, the adhesion of polyesters is improved. One of ordinary skill in the art would have wanted to take advantage of this property in the coating applications of Epple.

Allowable Subject Matter

5. Claims 6 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 2-4, 7, 10-12, and 15-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments with respect to the rejections made under 35 U.S.C. §103 have been considered but are moot in view of the new ground(s) of rejection.
8. Regarding the rejection of the claims under 35 U.S.C. §112, 2nd paragraph, applicant's arguments are not persuasive because although it may be unlikely that the Solvesso® 150 would be changed, this could still be the case. In addition, the use of C10-11 aromatic fluid is not sufficiently descriptive of Solvesso® 150. However, favorable consideration would be given to insertion of the specific product properties as set forth in the property data sheet that accompanied applicant's response.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR